

## REMARKS

### I. Introduction

This is in response to the Final Office Action dated May 14, 2009 and is being submitted concurrently with a Request for Continued Examination pursuant to 37 C.F.R. § 1.114. .

The Office Action rejected claims 1-4, 6-7, 9-10, and 21-22 under 35 U.S.C. § 101.

The Office Action rejected claims 1-4, 6-7, 9-14, 16-17, and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0198803 to Rowe (*hereinafter* “Rowe”) in view of U.S. Patent No. 3,634,669 to Fredregill et al. (*hereinafter* “Fredregill”) and U.S. Patent No. 3,634,669 to Soumas et al. (*hereinafter* “Soumas”). The Office Action rejected claims 21-24 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Rowe, Fredregill, and Soumas in further view of Jennifer Kinson Bloom, “New B of A Card Offers Discounts on Bank Products,” *American Banker*, New York, N.Y., vol. 1162, issue 229, pg. 3 (Dec. 1, 1997) (*hereinafter* “Bloom”).

In response, Applicants have amended claims 1-3, 6, 11, 21. Claims 5, 8, 15, and 18 were previously canceled without prejudice or disclaimer of the subject matter recited therein. Claims 1-4, 6, 7, 9-14, 16, 17, and 19-24 remain for consideration. No new matter has been added.

### II. Rejection under 35 U.S.C. § 101

Claims 1-4, 6-7, 9-10, and 21-22 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner contends that these claims are neither tied to a machine nor transform underlying subject matter.

In view of the Examiner’s rejections, Applicants have amended claims 1-3 and 6. These amendments tie the performance of the method steps to “a consumable account device.” Figure 1 and Paragraphs [0008] – [0015] of the Specification describe various features and operations of a consumable account device. In particular, the consumable account device can be operated by a bank or independent organization, and is accessible via network. *See* Specification, ¶ [0014]. Accordingly, the consumable account device is a particular machine. Thus, because independent

claim 1 is tied to a consumable account device, and consequently to a particular machine, claim 1 and all claims depending therefrom, recite statutory subject matter under 35 U.S.C. § 101.

For at least the reasons discussed above, Applicants respectfully request reconsideration and withdrawal of this rejection.

### **III. Rejections under 35 U.S.C. § 103(a)**

Independent claims 1 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Rowe, Fredregill and Soumas. In order to “establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art.” In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. Applicants respectfully submit that none of the cited references, either alone or in combination, disclose or suggest all of the claim limitations of independent claims 1 and 11 as amended. Therefore, Applicants request the withdrawal of the rejection under 35 U.S.C. § 103(a).

The present invention is directed to a consumption investment system that permits consumers to deposit value corresponding to their consumables as principal in an account. *See* Specification, ¶ [0003]. The principal can accrue interest in the account, which the consumer can then use to this or her benefit. However, the principal that was deposited (i.e., the value of the corresponding consumer purchased) cannot be consumed again. The consumer can only gain benefit from the interest accrued in the account. *See* Specification, ¶ [0003].

These and other features of the present invention are recited by the claims. In particular, Applicants have amended independent claim 1 to recite the step of “prohibiting withdrawal of the principal in the consumable account device for use in further consumption.” Similarly, independent claim 11 has been amended to recite “a controller coupled to the memory, the controller configured to . . . prohibit withdrawal of the principal for use in further consumption.” Thus, method and system of respective independent claims 1 and 11 do not allow the consumer to withdraw the principal deposited in the account.

Applicants submit that this feature is not recited by Rowe or any other cited reference, either individually or in combination. Therefore, claims 1 and 11, and all claims depending therefrom are allowable.

Rowe is directed to a method and system for facilitating monetary and commercial transactions. Rowe discloses, at paragraphs [0010]-[0013], defined benefit programs, such as the “American Express Platinum Cash Rebate Cards which gives 2% cash back on purchases” and the “Gold Delta SkyMiles Card which gives the consumer 10,000 SkyMiles with the first purchase and allows the consumer to earn 1 SkyMile for every eligible dollar spent.” Rowe, ¶¶ [0011] and [0012].

While, the American Express Platinum Cash Rebate Card disclosed by Rowe, describes providing a percentage return on a purchase made, the program does not disclose “depositing value as principal,” “accruing earned value,” and “prohibiting withdrawal of the principal,” as recited by claim 1. Rather, this benefit program provides a **one-time cash payment** based on the purchases made with the card. The value of the purchase is not deposited in an account, nor does the value accrue interest. The Gold Delta SkyMiles Card merely discloses providing SkyMiles for each dollar spent, but does not disclose accruing interest. In contrast to Rowe, the present invention uses the value of consumed goods as principal and accrues interest on the principal, such that as long as the principal is not depleted, the consumer continues to gain benefits, and the consumer cannot withdraw the principal.

Fredregill discloses an in-store point accumulation system that enables consumers to earn points during transactions at participating retailers. The points can then be redeemed for a reduction of the price of a redeemable item. *See* Fredregill, Abstract. Soumas discloses accruing interest on a monthly invested at a specific interest rate. *See* Soumas, col. 4, lines 46-56. The Examiner contends that it would have been obvious to one of ordinary skill in the art to combine Rowe, Fredregill, and Soumas “to provide a computer based investment calculator or spread sheet which enables one to determine the future value of his/her saving [sic] based on desired annual interest rate incrementally for different interest rate/terms or at a fix interest rate/terms.” Detailed Action, item 2, page 5.

Applicants submit that the combination of Rowe, Fredregill, and Soumas would not result in the invention recited by amended claim 1. Applicants first note that the result of the combination of cited references described by the Examiner does not comprise a “consumable investment system,” as recited by the claims. Furthermore, the Examiner’s description of the resulting system does not disclose “depositing value as principal,” “accruing earned value,” and “prohibiting withdrawal of the principal,” but rather discloses “a computer based investment calculator to determine the future value of his/her saving [sic] . . . .”

Moreover, Applicants submit that none of the references disclose “prohibiting withdrawal of the principal in the consumable account device for use in further consumption,” as recited by claim 1. As noted above, Rowe does not disclose depositing a principal amount in an account that earns interest. Rather, Rowe discloses a one-time percentage payment based on the amount of the transaction (e.g., the American Express Platinum Cash Rebate Cards) and a system (e.g., Gold Delta SkyMiles) that provides points (e.g., SkyMiles) for each dollar spent but does not accrue interest and provides a benefit only to the extent the consumer can access the points. Thus, Rowe does not disclose an account that accrues interest and prohibits the withdrawal of principal.

Fredregill discloses a system similar to the Gold Delta SkyMiles program. That is, in accordance with Fredregill, the consumer is benefited only to the extent the consumer can withdraw the redemption points earned. Soumas discloses a conventional investment account in which the user deposits money that accrues interest at a specific rate. However, the user is allowed access to both the principal (i.e., the deposited money) and the interest accrued. Thus, neither Fredregill nor Soumas disclose “prohibiting withdrawal of the principal in the consumable account device for use in further consumption,” as recited by claim 1.

Applicants respectfully submit that none of the other references cited by the Examiner cure the deficiencies of the references discussed above. Therefore, for at least the reasons discussed above, claim 1 is allowable.

Independent claim 11 has been amended to recite features similar to those of claim 1 discussed above. Therefore, for at least the reasons discussed above, claim 11 is allowable.

All of the remaining claims depend from an allowable base claim and therefore are also allowable.

#### **IV. No New Matter**

The amendments to claims 1-3, 6, 11, and 21 do not add new matter. Support for these amendments can be found at least at paragraphs [0003], [0009], [0014], and [0015] of the Specification.

#### **V. Conclusion**

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

If this communication is filed after the shortened statutory time period has elapsed and no separate Petition is enclosed (or the enclosed Petition is insufficient), the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 06-2143.

Respectfully submitted,

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